

REMARKS/ARGUMENTS

The rejections presented in the Office Action dated May 4, 2007 (hereinafter Office Action) have been considered. Claims 1-34 remain pending in the application. Claims 2-19, 21-28, and 30-33 are withdrawn as purportedly being directed to nonelected species. Claims 1, 20, 29, and 34 have been examined and stand rejected. None of the claims have been amended, and no claim has been added. Reconsideration of the application and withdrawal of the present rejections is respectfully requested.

Claims 1, 29 and 34 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,172,668 to Baur (hereinafter “*Baur*”). Claim 20 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Baur* in view of U.S. Patent No. 4,320,292 to Oikawa et al. (hereinafter “*Oikawa*”).

Applicant’s claims 1, 20, 29, and 34 recite, in various forms, a stylus configured to collect ambient light and emit the collected light, the stylus producing a defined intensity profile detectable by the user input device. Applicant’s specification, on page 6, lines 17-23, discloses that:

Further, as used herein, the term “defined intensity profile” refers to a predictable light pattern produced by a stylus of the present disclosure, the light pattern having one or more dark regions that at least partially surround one or more light regions, where the contrast between the one or more dark regions and the one or more light regions is sufficient for detection by a user input device. What constitutes sufficiency for detection can be adjusted by setting detection thresholds, with the caveat that lower thresholds may result in a device that is more susceptible to noise.

It is a fundamental principle that Applicants are their own lexicographers, and that they can define in the claims what they regard as their invention essentially in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the specification. MPEP § 2173.01. Further, claims must be given their broadest reasonable interpretation consistent with the specification, as it would be interpreted by one of ordinary skill in the art. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005)(citing *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004); *see also* MPEP § 2111.

Applicant respectfully submits that the meaning of the term “defined intensity profile,” as recited in Applicant’s claims 1, 20, 29, and 34, is clearly set forth in Applicant’s specification at page 6, lines 17-23 and elsewhere, illustrative examples of which are provided in Figures 7(a)-7(c) and accompanying text. Applicant further submits that *Baur*, alone or in combination with *Oikawa*, does not disclose this feature of Applicant’s claimed stylus, device, system, or method of using same.

On page 3 of the Office Action, the Examiner cites column 2, lines 43-51, column 59-62, column 1, lines 9-11, and column 2, lines 46-51 as purportedly teaching production of a defined intensity profile by *Baur*’s stylus. A careful review of these and other portions of *Baur* reveals that *Baur* is devoid of an express or implicit teaching that its stylus produces a predefined intensity profile. The relied-on portions of *Baur* merely describe the light pen as illuminating a spot on a display or simply directing light towards the tip of the stylus. *Baur* further fails to disclose a user input device or electronics configured to detect a defined intensity profile produced by a stylus.

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Therefore, all claim elements, and their limitations, must be found in the prior art reference to maintain a rejection based on 35

U.S.C. §102. Applicant respectfully submits that *Baur* does not teach every element of claims 1, 20, 29, and 34, and therefore fails to anticipate these claims.

It is further submitted that Applicant's recited features of a stylus that produces a defined intensity profile and a user input device or electronics configured to detect a defined intensity profile produced by the stylus are not inherent features of *Baur's* device. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). One skilled in the art would not consider these features of Applicant's claims to be "necessarily present" in *Baur's* device.

Because each and every element of claims 1, 20, 29, and 34 are not found, expressly or inherently, in *Baur*, these claims are not anticipated by *Baur*. Applicant respectfully submits that withdrawal of the anticipation rejection of claims 1, 20, 29, and 34 is necessitated, as the rejection of these claims as being anticipated by *Baur* is not sustainable.

Regarding the rejection of claim 20 under 35 U.S.C. §103(a) as being unpatentable over *Baur* in view of *Oikawa*, Applicant respectfully disagrees with the Examiner's characterization of what is taught in column 6, lines 45-64 of *Oikawa*. *Oikawa* teaches that when the tip 34 retracts into the casing when the light pen is urged against the surface of the optical guide channel, the permanent magnet 36 actuates a reed switch S1, which causes the light emitting diode LD to luminesce. Contrary the Examiner's characterization, this portion of *Oikawa* does not describe a cylinder that is slidably coupled to the tip such that the cylinder changes the cross-sectional area of the emitted light when at least a portion of the tip is in contact with the input surface of the user input device.

Because *Oikawa* fails to teach or suggest all features of Applicant's claim 20, and further because the combination of *Baur* and *Oikawa* fails to teach or suggest all features of Applicant's claims 1 and 20, claim 20 is not rendered obvious by the combination of *Baur* and *Oikawa*. Moreover, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Applicant respectfully submits that withdrawal of the obviousness rejection of claim 20 is necessitated, as the rejection of these claims as being obvious over *Baur* and *Oikawa* is not sustainable.

It is to be understood that Applicant does not acquiesce to Examiner's characterization of the asserted art or Applicant's claimed subject matter, nor of the Examiner's application of the asserted art or combinations thereof to Applicant's claimed subject matter. Moreover, Applicant does not acquiesce to any explicit or implicit statements or conclusions by the Examiner concerning what would have been obvious to one of ordinary skill in the art, obvious design choices, alternative equivalent arrangements, common knowledge at the time of Applicant's invention, officially noticed facts, and the like. Applicant respectfully submits that a detailed discussion of each of the Examiner's rejections beyond that provided above is not necessary, in view of the clear absence of teaching and suggestion of various features recited in Applicant's pending claims. Applicant, however, reserves the right to address in detail the Examiner's characterizations, conclusions, and rejections in future prosecution.

Applicant respectfully submits that claims 1, 20, 29, and 34 are in condition for allowance and requests early indication of same.

Applicant respectfully reminds the Examiner that, upon allowance of generic claims 1, 29, and 34, Applicant is entitled to consideration of claims to additional species, including those identified by the Examiner, pursuant to 37 CFR 1.141. As such, Applicant respectfully requests rejoinder of the claims to the additional species in view of the clear basis for allowance of generic claims 1, 29, and 34.

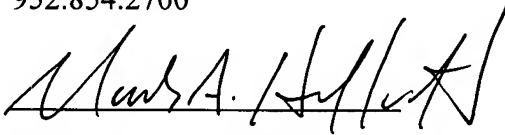
Authorization is given to charge Deposit Account No. 50-3581 (MMM.074.A1) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the Examiner is invited to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

HOLLINGSWORTH & FUNK, LLC
8009 34th Avenue South, Suite 125
Minneapolis, MN 55425
952.854.2700

Date: September 4, 2007

By:

A handwritten signature in black ink, appearing to read "Mark A. Hollingsworth", written over a horizontal line.

Mark A. Hollingsworth
Reg. No. 38,491